

## **REMARKS**

By way of summary, Claims 1-5, 7-16, 18, and 20-29 were pending in the present application. In this Response, Claims 1, 20, and 26 have been amended. Accordingly, Claims 1-5, 7-16, 18, and 20-29 remain pending for consideration.

### **35 U.S.C. §103(a) Rejection of Claims 1, 3-4, 7-8, 10-12, 14-16, 20, and 26-29 over Beane in view of Gunday**

#### **1. Independent Claim 1**

The Office Action rejected Claims 1, 3-4, 7-8, 10-12, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Beane (US 2002/0022762) in view of Gunday (US 7,453,490). Applicants respectfully traverse this rejection because Beane, alone or in combination with Gunday, fails to teach or suggest “a *non-porous* whitening element within or at the distal end of said tube that enables white balancing of said optical instrument” as required by amended Claim 1.

The Office Action states that it would have been obvious to use the porous sponge 116 of Beane as a whitening element because Gunday discloses the use of white gauze or cloth as non-ideal whitening elements. However, Gunday teaches that when using a non-ideal reference target such as a piece of white gauze or cloth, the “pattern and/or texture of the target will be detected by the imaging detector (e.g., a shadowing effect) and will be manifest in the imaging signal(s) as one or more high frequency artifacts . . .” Col. 11, lns. 12-23. Gunday further explains that “correction generally will be subject to such artifacts” and removal of the artifacts “typically is accomplished via a filtering function such as, e.g., a digital low pass filter.” Col. 11, lns. 25-32. In contrast, as shown in Figure 7 of the present application, the whitening element 26, 28 of Claim 1 is non-porous, thereby providing a substantially even surface for proper white balancing or optical calibration of the optical instrument. The non-porous whitening element of the present claims advantageously allows for white balancing or calibration without the need for such correction and/or filtering.

Claims 3-4, 7-8, 10-12, and 14-16 are dependent claims that depend from independent Claim 1 and include at least all of the limitations of the independent claim from which they depend plus the additional limitations recited therein. Therefore Applicants respectfully request the

rejections of Claims 1, 3-4, 7-8, 10-12, and 14-16 under 35 U.S.C. § 103(a) as obvious over Beane in view of Gunday be withdrawn for at least the reasons provided above.

**2. Independent Claim 20**

The Office Action rejected Claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Gunday. Applicants respectfully traverse this rejection because Beane, alone or in combination with Gunday, fails to teach or suggest “a *non-porous* whitening element within or at the distal end of said tube-like structure, the whitening element usable to provide a basis for optical calibration of the optical instrument” as required by amended Claim 20.

Applicants submit that independent Claim 20 is patentable for at least the same reasons provided above with respect to independent Claim 1. Therefore, Applicants respectfully request the rejection of Claim 20 under 35 U.S.C. § 103(a) as obvious over Beane in view of Gunday be withdrawn for at least the reasons provided above.

**3. Independent Claim 26**

The Office Action also rejected Claims 26-29 under 35 U.S.C. § 103(a) as being unpatentable over Beane (US 2002/0022762) in view of Gunday (US 7,453,490). Similarly to amended Claims 1 and 20, amended Claim 26 recites “calibrating said optical instrument while inserted in said device using a *non-porous* whitening element.” Applicants submit that independent Claim 26 is patentable for at least reasons similar to those provided above with respect to independent Claim 1. Claims 27-29 are dependent claims that depend from independent Claim 26 and include at least all of the limitations of the independent claim from which they depend plus the additional limitations recited therein. Therefore Applicants respectfully request the rejections of Claims 26-29 under 35 U.S.C. § 103(a) as obvious over Beane in view of Gunday also be withdrawn for at least the reasons provided above.

**35 U.S.C. § 103(a) Rejection of Claim 9 over Beane in view of Gunday and Agarwal**

The Office Action rejected Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Gunday and Agarwal et al. (US 2003-0124277). Claim 9 is a dependent claim that depends from independent Claim 1 and includes at least all of the limitations of Claim 1 as

well as the additional limitations recited therein. Therefore, Applicants respectfully request the rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Gunday and Agarwal be withdrawn for at least the reasons provided above.

**35 U.S.C. §103(a) Rejection of Claims 2, 5, 13, 18, and 21-25 over Beane in view of Gunday and Mukaida**

The Office Action rejected Claims 2, 5, 13, 18, and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Gunday and Mukaida (US 6,789,644). Claims 2, 5, 13, and 18 are dependent claims that depend from independent Claim 1, and Claims 21-25 are dependent claims that depend from independent Claim 20. These dependent claims include at least all of the limitations of the independent claim from which they depend as well as the additional limitations recited therein.

Furthermore, dependent claims 5 and 25 recite that the “double walled cylindrical tube has a horizontal cavity extending from said external wall through said distal portion of said aperture, sized and shaped to fit said whitening element.” As explained on page 8, lines 28-33 and shown in Figure 8 of the present application as filed, in some embodiments, “a cavity 27 may be formed during the plastics moulding process to provide an opening extending from the double walled cylindrical tube outer surface and inner surface, across the distal portion of the cylindrical protrusion . . . towards the opposite inner surface wall. Hence a removable whitening block 28 may be inserted into the double walled cylindrical tube cavity 27 opening . . . .”

The Office Action states that the slits 144a, b of Beane are a horizontal cavity extending from the external wall through the distal portion of the aperture, sized and shaped to fit the whitening element. However, as Beane explains, “[s]lits 144a, 144b allow a surgeon to squeeze bottle 118.” Par. [0056]. The sponge 116, which the Office Action states is a whitening element, “is disposed within tube 114, near distal end 124.” Par. [0054]. The slits 144a, b do not extend into the tube 114 and are not sized and shaped to fit the whitening element as required by dependent claims 5 and 25.

Therefore, Applicants respectfully request the rejections of Claims 2, 5, 13, 18, and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of Gunday and Mukaida be withdrawn for at least the reasons provided above.

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*No Disclaimers or Disavowals*

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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